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In re Application of MESSE et al :
U.S. Application No.: 10/516,978 :
PCT Application No.: PCT/GB03/02410 :
Int. Filing Date: 04 June 2003 : DECISION
Priority Date Claimed: 06 June 2002 :
Attorney Docket No.: 128905-1004 (HAM 830006) :
For: ACTINIC RADIATION CURABLE :
COMPOSITIONS AND THEIR USE :

This is in response to the "Satisfaction of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" filed 22 August 2005, which is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 04 June 2003, applicant filed international application PCT/GB03/02410, which claimed priority of an earlier United Kingdom application filed 06 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 December 2004.

On 03 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 August 2005, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Barrie Hayes refuses to sign the application papers. However, petitioner has not adequately shown that a bona fide attempt was made to present a copy of the application papers to Hayes for signature. In particular, the letter dated 09 February 2003 did not include a copy of the application papers. The hypertext link in the body of the letter is not equivalent to providing an actual copy of the application papers. Furthermore, the link is not operational. Moreover, the petition does not include documentary evidence (i.e. a copy of the DHL confirmation) which illustrates that the correspondence was received by Hayes. In addition, the petition does not sufficiently demonstrate that Hayes refuses to sign. Specifically, the affidavit of Britt Van Essche fails to provide details of applicant's response to Hayes' letter dated 20 February 2005. It is noted that Hayes' letter does not state that he refuses to sign. Thus, it would not be reasonable to conclude at the present time that Hayes refuses to join in the application.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to \$200.00. Any fee deficiency will be charged to Deposit Account No. 08-3442 as authorized by applicant.

With regard to item (4) above, the petition does not state the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)".

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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